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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,577	12/06/2001	Kenichi Asada	P/3236-36	4980

7590 07/31/2006

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 07/31/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/006,577
Filing Date: December 06, 2001
Appellant(s): ASADA, KENICHI

MAILED

JUL 30 2006

Technology Center 2600

Joseph W. Ragusa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 8, 2006 appealing from the Office action mailed July 14, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,169,905	FUKUDA	1-2001
4,989,230	GILLIG ET AL.	1-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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The following is a repetition of the rejections found in final Office action mailed July 14, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-10, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (US Patent Number 6,169,905) in view of Gillig et al. (US Patent Number 4,989,230).

Regarding **claim 1**, Fukuda discloses a notification system (Figure 4) for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 5, line 28; and column 6, line 56) including:

a system configuration (Figures 4-5) for allowing said sender phone to transmit an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver phone being in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

such that said main power source of said receiver phone is remotely turned ON (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

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However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 2**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 1*). In addition, Fukuda discloses that after said receiver cellular phone becomes in said ON state, said receiver cellular phone is notified that a call is received (analog audio signal; the user can answer the incoming call – column 7, lines 1-25).

Regarding **claim 3**, Fukuda discloses a notification system (Figure 4) for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 6, line 56) including:

a base station controlling device (“main master station 1” – column 5, line 55) for receiving receiver information (connection request control signal – column 1, line 30; column 6,

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line 45-47) “concerning” said receiver phone which main power source is in an OFF state (power supply of reception unit OFF), and for controlling at least one base station (“sub master stations 2 and 3” – column 5, lines 56-57) covering an area (inherent) indicated in said receiver information (column 5, lines 53-63); and

a base station (“sub master stations 2 and 3” – column 5, lines 56-57) for sending said receiver information, wherein:

said base station comprises a sub-system configuration for sending power-ON information (control signal – Figure 5) based on said receiver information received from said base station controlling device; and

said receiver phone comprises a device configuration for receiving said power-ON information from said base station even if said main power source is in said OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines) (see column 3, lines 58-60; column 4, lines 11-13; column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 4**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 3*). In addition, Fukuda discloses that the receiver information includes at least one of a receiver cellular phone telephone number, a password to access said receiver cellular prone, and area information indicating an area where said receiver cellular phone is predicted to be. For example, identification No. of the target remote station (receiver cellular phone telephone number) (column 2, line 9).

Regarding **claim 6**, Fukuda discloses a method for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 5, line 28; and column 6, line 56) including:

transmitting, by said sender phone, an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver phone being in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

turning ON said main power source of said receiver phone in response to said ON state indication signal (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 8**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). In addition, Fukuda discloses that after said receiver cellular phone becomes in said ON state, said receiver cellular phone is notified that a call is received (analog audio signal; the user can answer the incoming call – column 7, lines 1-25).

Regarding **claim 9**, Fukuda discloses a phone (remote station 4 – Figure 4) comprising a device configuration for receiving a signal (control signal – Figure 5) for switching to be in an ON state from a base station (master station – Figure 4; column 5, lines 53-63) and being capable of switching a main power source to be in said ON state even if said main power source is in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a

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control signal – abstract, last three lines; column 3, lines 58-60; column 4, lines 11-13; see also column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 10**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 9*). In addition, Fukuda further discloses:

1) Establishing synchronization with at least said base station (via "sync word" in control signal – column 5, line 40) even if said main power source is in said OFF state (the remote station receives the control signal even when in standby mode which is an OFF state because the power supply of its reception unit is OFF – column 6, lines 25-30; column 2, lines 10-12).

Therefore, a synchronization establishing circuit as claimed is inherent.

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2) Extracting main power source ON information from a radio wave (column 5, line 29) transmitted from said base station (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines; column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59). Therefore, a main power source ON information detecting section as claimed is inherent.

3) A power source section (these limitations are inherent from above because the claimed circuit inherently needs power to operate) for supplying electric power to said main power source ON information detecting section and a location information detecting section to be kept in an ON-state, even if said main power source is in said OFF state, and for turning ON said main power source when said main power source ON information is input from said main power source ON information detecting section (abstract; column 3, lines 58-60; column 4, lines 11-13; and column 6, lines 42-59).

Regarding **claim 12**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 9*). As explained above Fukuda and Gillig et al. disclose the claimed cellular phone. The cellular phone “is used” as a receiver cellular phone in a notification system for communicating between a sender cellular phone and said receiver cellular phone. In addition, Fukuda further discloses wherein said notification system comprises:

a system configuration (Figures 4-5) for allowing said sender phone to transmit an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver phone (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

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such that said main power source of said receiver phone is remotely turned ON (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

Regarding **claim 14**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). In addition, Fukuda discloses that an OFF state status indication can be accessed from said receiver cellular phone (see the abstract, last three lines).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda in view of Gillig et al. as applied to *claim 6* above, and further in view of MPEP 2144.03. Tsuchiyama (US Patent Number 5,847,657).

Regarding **claim 7**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). However, they fail to specifically disclose confirming that the main power source of the receiver cellular phone to be notified is in the OFF state.

The examiner contends that such confirmation step is well known in the art and takes Official notice of such notion, because it is unnecessary to send a switch ON signal if the intended recipient is already ON. It is always desirable to remotely turn ON electronic devices that currently are in OFF state, not ON.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda and Gillig et al.'s invention to confirm that the receiver cellular phone is in the OFF state before remotely turning it ON, because it is unnecessary to transmit a switch ON signal if the intended recipient is already ON.

(10) Response to Argument

APPELLANT'S ARGUMENTS:

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(1) Introductory Argument A (pages 5-10): First summarizes Appellant's interpretation of independent claims 1, 3, 6 and 9 (pages 5-8). Then argues that "the disclosure of Fakuda fails to teach or suggest that any signal is sent to a terminal to instruct that the terminal turn on its power" (page 9, fourth paragraph) and that "the phrase 'on the basis of the control signal' must have some other meaning than that suggested by the Examiner" (page 9, last paragraph continuing into page 10).

(2) Subtitle/argument A (pages 10-11): Appellant argues Fukuda's controls ON/OFF timing so as to synchronize with receipt of the control signal. Such that Fukuda's remote station is turned ON based on timing considerations, not based on an ON state indication signal (page 11, third full paragraph).

(3) Subtitle/argument A (pages 11-12): Appellant argues that the interpretation of the abstract in the final Office action is contrary to the teachings of the specification.

(4) Argument A1 (page 12): Appellant argues that the detailed description is not a different embodiment.

(5) Argument A2 (pages 12-14): Appellant argues that the interpretation of Fakuda's abstract in the final Office action is at odds with the detailed description. Because "the Final Office Action, on the other hand, would interpret that Abstract by ignoring the *only* explanation in the detailed description that relates to the relied upon passage of the Abstract" (*emphasis in original* - page

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13, first full paragraph). And that “if the interpretation set forth in the Final Office Action is accepted, then the detailed description describes a system that works differently from the system ‘described’ in the Abstract” (page 14, first full paragraph).

(6) Subtitle/argument A2 (pages 14-15): Appellant argues that in any event, Fukuda deals with turning ON/OFF of the reception unit power while the independent claims relate to the turning ON/OFF of main power, because the abstract is allegedly incorrectly interpreted (page 15, first paragraph). Appellant further states that Gillig does not cure the deficiencies of Fukuda (page 15, third paragraph).

(7) Argument B (pages 15-16): Appellant argues the same “reasons discussed above” for dependent claims 2, 4, 7, 8, 10, 12 and 14.

EXAMINER'S RESPONSE:

(1) Appellant's essential argument is that the phrase “on the basis of the control signal” found, for example, in Fukuda's abstract must have some other meaning than that suggested by the Examiner because the interpretation of the abstract in the final Office action is contrary to the teachings of the specification. In support to this argument Appellant further argues that Fukuda's remote station is turned ON based on timing considerations, rather than based on an ON state indication signal.

In response, at the outset the specification considered as a whole includes the abstract. The body of Fukuda's disclosure does support Examiner's interpretation as shown in the sections

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cited in the final Office action (see for example page 3, lines 3-4 of final Office action). Column 3, lines 58-60 and column 4, lines 11-13 does teach that the remote station turns ON the power supply on the basis of the control signal (claimed ON state indication signal). Column 6, lines 42-49 teach that the remote station discriminates the content of the control signal and performs the predetermined operation (turning ON) on the basis of the content of the received control signal. Consequently, Appellant's finding of timing considerations is without more another alternative.

Based on Fukuda's disclosure one of ordinary skill in the art would recognize that the phrase "on the basis of the control signal" means based on the content of the control signal in harmony with column 6, lines 42-49.

Applicant's definition of OFF state allows the receiver cellular phone to still receive the ON state indication signal because some parts always remain in the power-ON state (original specification page 13, lines 2-6; also column 11, lines 20-23; column 5, lines 26-29; column 6, lines 1, 13-17). Claims are given their broadest reasonable interpretation in light of the supporting disclosure (MPEP 2111). Consequently, "power-OFF state" or power is OFF when one part is OFF. That is the same teaching Fukuda discloses. In order for Fukuda's remote station to be able to receive the control signal Fukuda's OFF state still enables the receiving of the control signal. Then "main power" as claimed is tuned ON on the basis of the content of the control signal.

(2) Appellant argues Fukuda's remote station is turned ON based on timing considerations, not based on an ON state indication signal.

In response, the body of Fukuda's disclosure does teach that the remote station is turned ON based on the content of the control signal. Column 3, lines 58-60 and column 4, lines 11-13 does teach that the remote station turns ON the power supply on the basis of the control signal (claimed ON state indication signal). Column 6, lines 42-49 teach that the remote station discriminates the content of the control signal and performs the predetermined operation (turning ON) on the basis of the content of the received control signal. Consequently, Appellant's finding of timing considerations is without more another alternative.

The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

(3) Appellant argues that the interpretation of the abstract in the final Office action is contrary to the teachings of the specification.

In response, the specification considered as a whole includes the abstract. The body of Fukuda's disclosure does support Examiner's interpretation as shown in the sections cited in the final Office action. Based on Fukuda's disclosure one of ordinary skill in the art would recognize that the phrase "on the basis of the control signal" means based on the content of the control signal in harmony with column 6, lines 42-49.

(4) Appellant argues that the detailed description is not a different embodiment based on the finding that Fukuda's remote station is turned ON based on timing considerations.

In response, the specification considered as a whole includes the abstract. One of ordinary skill in the art would recognize that the phrase “on the basis of the control signal” means based on the content of the control signal in harmony with column 6, lines 42-49 of Fukuda. Consequently, Appellant's finding of timing considerations is without more another alternative.

(5) Appellant argues that the interpretation of Fukuda's abstract in the final Office action is at odds with the detailed description because the final Office action would interpret the abstract by ignoring the *only* explanation in the detailed description that relates to the relied upon passage of the abstract. Further that if the interpretation set forth in the final Office action is accepted, then the detailed description describes a system that works differently from the system described in the abstract.

In response, the sections cited in the final Office action (see for example page 3, lines 3-4 of final Office action) include Fukuda's disclosure. As explained above, Fukuda's column 3, lines 58-60 and column 4, lines 11-13 teach that the remote station turns ON the power supply on the basis of the control signal (claimed ON state indication signal); and column 6, lines 42-49 teach that the remote station discriminates the content of the control signal and performs the predetermined operation (turning ON) on the basis of the content of the received control signal. Hence, Fukuda's disclosure is in complete harmony with that described in the abstract.

One of ordinary skill in the art would recognize that the phrase “on the basis of the control signal” means based on the content of the control signal in harmony with column 6, lines 42-49. Applicant's definition of OFF state allows the receiver cellular phone to still receive the

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ON state indication signal because some parts always remain in the power-ON state (original specification page 13, lines 2-6; also column 11, lines 20-23; column 5, lines 26-29; column 6, lines 1, 13-17). Claims are given their broadest reasonable interpretation in light of the supporting disclosure (MPEP 2111). Thus, Applicant's "power-OFF state" or power is OFF when one part of the device is OFF. That is the same teaching Fukuda discloses. In order for Fukuda's remote station to be able to receive the control signal Fukuda's OFF state still enables the receiving of the control signal. Then "main power" as claimed is tuned ON on the basis of the content of the control signal.

(6) Appellant argues that Fukuda is different from claimed language because Fukuda deals with turning ON/OFF of the reception unit power while the independent claims relate to the turning ON/OFF of main power. Also because the abstract is allegedly incorrectly interpreted. Appellant further states that Gillig does not cure the deficiencies of Fukuda.

In response, Applicant's definition of OFF state allows the receiver cellular phone to still receive the ON state indication signal because some parts always remain in the power-ON state (original specification page 13, lines 2-6; also column 11, lines 20-23; column 5, lines 26-29; column 6, lines 1, 13-17). Claims are given their broadest reasonable interpretation in light of the supporting disclosure (MPEP 2111). Consequently, "power-OFF state" or power is OFF when one part is OFF. That is the same teaching Fukuda discloses. In order for Fukuda's remote station to be able to receive the control signal Fukuda's OFF state still enables the receiving of the control signal. Then "main power" as claimed is tuned ON on the basis of the content of the control signal.

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Further, the abstract has been correctly interpreted in light of Fukuda's supporting disclosure. One of ordinary skill in the art would recognize that the phrase "on the basis of the control signal" means based on the content of the control signal in harmony with column 6, lines 42-49. In addition, Gillig is not the reference relied upon to meet the argued limitations.

(7) Appellant argues the same reasons discussed above for dependent claims 2, 4, 7, 8, 10, 12 and 14.

In response, the same explanation detailed above is applied.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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